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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Khanna)	Art Unit: 2652
)	
Serial No.: 10/661,273)	Examiner: Renner
)	
Filed: September 11, 2003)	HSJ920030120US1
)	
For: METHOD AND APPARATUS FOR LIMITING SHOCK DAMAGE TO HARD DISK DRIVE DURING OPERATION)	December 18, 2005
)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

REPLY BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief responds to the Examiner's Answer dated December 14, 2005.

The Answer first responds by citing two cases (In re Fitzgerald and In re Swinehart) for the proposition that the Office may request a patent applicant to prove a negative, i.e., that a prior art reference does not possess an allegedly inherent characteristic. But no such request has been made to date. Accordingly, the citations to these cases is irrelevant.

Moreover, the cases are inapposite. In re Fitzgerald, for instance, involved a prior art reference that had each and every feature of the claimed self-locking threaded fastener, *and* used a cooling rate for its polymer as did the claimed invention and that, for all anyone knew, necessarily resulted in the claimed crystallization shrinkage rate. There was thus a question as to whether the claimed shrinkage rate *necessarily* was present in the prior art. Stated differently, the cases permitting an examiner to shift the burden of proof

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to an applicant come into play only once the examiner has proffered evidence or reasoning tending to show that an allegedly inherent characteristic *necessarily* is in the prior art.

Contrast that to the present rejections. The examiner has never reasoned that it would be impossible to establish the relied-upon distances to be so great as to allow disruption of the ABS, and indeed it is clear and easy logic to immediately discern that this indeed can be the case. The examiner has never denied that at some point it would be possible to establish the relied-upon distances to remove them from the claims. Indeed, regardless of where the distance between the relied-upon elements departs from providing the claimed feature, the fact is that the applied references plainly can be made with distances that would permit undue shock to disrupt the ABS, since no dimensional limitations are placed on the relied-upon distances. Thus, unlike the relied-upon cases in which a reasonable question existed as to whether the prior art *necessarily had* to be made in a way that would arrive at the claimed invention, here it is clear that the references could indeed be manufactured with distances between the relied-upon elements being so great as to supply no shock buffer to ABS disruption. In fact, as pointed out in the Brief but ignored in the Answer, Onda explicitly envisions ABS disruption. So it's back to square one, with the onus on the examiner to explain why the structure of the applied references *necessarily* arrives at the present claims.

Accordingly and considering the relevant legal standards, no evidence has been produced tending to show inherency, and until the present Answer no reasoning related to why the relied-upon references must necessarily arrive at the claims, apart from a mere unsupported conclusion, has been proffered. The only "reasoning" related to inherency to date is now propounded in the Answer, and it involves taking scissors and paste to Appellant's specification.

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Consider first the second full paragraph of page 12 of the Answer, which alleges that the present specification, page 2, lines 7 and 8 "in fact explains" that air bearing disruption is when the slider is lifted off the disk. Quite the contrary; what these two lines "explain" is that "at some point it can be anticipated that the air bearing will be disrupted *and* the slider lifted off the disk" (emphasis added). Thus, far from "explaining" that air bearing disruption equals slider motion away from the disk, the relied-upon disclosure clearly refers to air bearing disruption and slider motion away from the disk as being separate things.

The Answer then observes that Appellant has taught a distance that is sufficiently small so that in the event of shock the suspension remains close enough to the disk to avoid ABS disruption, "implying" that disruption will occur due to a large separation. Correct! Appellant's specification so teaches, and Appellant's claims so recite - but Appellant's specification and Appellant's claims are not part of the prior art. Had the relied-upon references said something along these lines, the examiner might have something. As it is, only Appellant has taught and claimed a specific structural relationship between two components that has not on the record been taught or suggested any place else.

The new "reasoning" concludes with an allegation that "it is seen" that in the event of a large enough shock, the claimed motion limiting element would not prevent ABS disruption since it does not constrain slider motion toward the disk, and this is somehow propitious in the conferees' minds because "Appellant has not provided any evidence supporting the notion that the motion limiting element prevents *all* contact between the slider and disk" (emphasis added). This is not "reasoning", it is a statement of a vision, because just why, precisely, the allegation following the phrase "it is seen" is correct in fact is not "seen". It is a guess devoid of any citation in support. If "it" has been "seen", who in the prior art has seen it? Why should a

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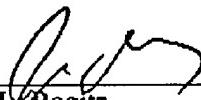
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hypothesis of the conferees be accorded weight when it is not supported by evidence and when it is not self-evidently correct? The divination of the conferees is not part of the prior art.

Appellant notes that the explicit teachings of Onda discussed in the Brief have been ignored in the Answer - as they must be, to continue avoiding allowance.

Appellant notes that no specific rebuttal beyond mere opposing conclusion has been presented in the Answer to the Brief's argument relating to the Japanese reference, which contains no English language teachings at all.

Respectfully submitted,


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